

REMARKS

The Office Action mailed January 27, 2009 has been reviewed and carefully considered. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1, 4-16 and 18 and 20 are pending in this application. Claims 1, 4, 5 and 15 have been amended. Claims 2, 3, 17 and 19 have been cancelled without prejudice. No new matter has been added.

§103 REJECTIONS

Claims 1, 3-6, 8 and 15-16, 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. Patent No. 6,341,306 to Rosenschein et al. (hereinafter Rosenschein). (Please note that the Office Action on page 2 listed Claims 2-5 and 15-20 as being rejected under 103; this was believed to be a typographical error).

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. 5999179 to Kekic et al. (hereinafter Kekic). Claims 9-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of "Shared Folders: Your Online Conference Room" by Doug Anderson, hereinafter "Anderson" and in further view of Microsoft Outlook 2003 Advanced Information Management in PC Today, by Jennifer Farwell (hereinafter Farwell). Applicant respectfully disagrees with the rejections.

Independent Claim 1 has been amended to recite, *inter alia*:

"...said options list including at least an associate option, a show associations option, and a hide associations option;

selecting an the associate option on the options list; and
selecting the second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form an associated group of e-mails; and
forming an associated group of e-mails in the user mailbox comprising at least two or more associated e-mails;

creating a reply email to at least one of the associated group of e-mails; and selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show information on its associations to a recipient.”

Independent claim 15 has been amended to recite, *inter alia*,

“...wherein the options list further comprises a show associations feature and a hide associations feature; and a reply email created for at least one of the associated group of e-mails, said reply e-mail being configured to show or hide information on its associations to a recipient.”

These amendments are supported by the specification, e.g., by FIG. 3 and its associated description on page 11, line 22 to page 12, line 21.

Applicant notes that the sorting system of Agrawal matches an incoming email to a profile of a folder, and does not enable an email to be directly associated to another email, as presently claimed. In Agrawal, one or more documents (emails) are moved into the folders based on their respective profiles. Each profile is determined based on a sample document which represents a user-desired example of the type of document that folder should contain. An incoming email is matched to a folder based on having the highest probability of matching content to the folder.

Thus, Agrawal's system is based on learning folder profiles based on sample documents and moves remaining documents into the folders accordingly. However, organizing emails by assigning them to folders with matching profiles (as in Agrawal) is not to be confused with associating e-mails *directly* to **each other**, as in the present invention. Of significant note, in Agrawal, since emails are organized by simply being assigned to folders, **a new folder must be created for each different topic**, and furthermore, in order for Agrawal's document association to occur, a sample document or rules representative of the

desired classification indicia must then be put into the folder to represent its profile. *See* Col.

4, lines 51-60:

“[A]s shown in block 50, the user can establish a tree-like hierarchy of empty folders by conventional means... Moving to block 52, the user inputs, for each folder, one or more classification indicia in the form of sample documents. In addition, the user can define classification rules such as “send all emails from John to folder #3.”

Accordingly, Agrawal requires a folder to be set up in advance (for each desired topic,

no less) in order to organize its emails. In stark contrast to Agrawal, the present invention advantageously provides a user-controlled e-mail organization technique **which eliminates the need to create a new folder for each discussion topic, and does NOT require advance set-up of folders**. In the present invention, emails which do not have the same sender or subject heading may be *directly* associated with each other. The fact that the need to create a new folder for each new topic is eliminated is, indeed, a key focus of the present invention. *See* specification, page 2, lines 4-10. In Agrawal, it is clear that any ‘grouping’ function involves wherein only emails which are similar to a sample document can be grouped together, and thus in any way ‘associated’ with each other.

Furthermore, Agrawal fails to disclose or suggest at least selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show information on its associations to a recipient, essentially as claimed in Claim 1. Agrawal also fails to disclose or suggest wherein the options list further comprises a show associations feature and a hide associations feature; and a reply email created for at least one of the associated group of e-mails, said reply e-mail being configured to show or hide information on its associations to a recipient, essentially as claimed in claim 15. Indeed, it is reiterated that the entire system and method of Agrawal is directed towards organizing documents on a user’s personal computer only. There is no mention whatsoever of any means for controlling how an email is to be displayed to a

recipient, namely, whether information on an e-mail's associations may be shown to or hidden from a recipient of the email.

It is respectfully asserted that Rosenschein fails to cure the deficiencies of Agrawal. Rosenschein involves a system for obtaining and retrieving information from a database by designating at least one word appearing in a display of a body of text generated by a first computer, wherein the at least one designated word is transmitted via a network to a second computer. Data relating to the at least one designated word are received from the second computer. However, Rosenschein has nothing to do with email organization, much less organizing e-mail messages to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes. Indeed, the Examiner merely cited Rosenschein as allegedly teaching right clicking on an options list. However, it is readily apparent that Rosenschein fails to disclose or suggest at least selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show information on its associations to a recipient, essentially as claimed in Claim 1. Rosenschein also fails to disclose or suggest wherein the options list further comprises a show associations feature and a hide associations feature; and a reply email created for at least one of the associated group of e-mails, said reply e-mail being configured to show or hide information on its associations to a recipient, essentially as claimed in claim 15.

Applicant notes that with respect to claim 9, the Examiner has now admitted that Agrawal does not disclose controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide

associations option on a reply e-mail to be sent to a recipient. The Examiner cites Farwell as allegedly disclosing this feature, however the Applicant respectfully disagrees.

The cited “Choose A Category” section of Farwell discusses a “Categories tool” which lets one identify a variety of items (e.g., email messages) as they relate to a situation or purpose, such as Ideas or Time and Expenses. Farwell states that an unlimited number of categories can be assigned to an item, and that categories can be used to process specific tasks, asserting: “[F]or example, after you assign a category to a group of contacts, you can send a mass distribution email to the entire category at once.” However, Farwell’s disclosed ‘assigning of items to categories’ is simply another organizational technique, and does not relate in any way with creating a reply to an email that is from a group of associated emails, the reply being configured to show or hide its associations to a recipient, as in the present invention.

Farwell’s ability to send a “mass distribution email” to an entire category at once is NOT to be confused with controlling whether a recipient of an email is allowed to see any of its associated emails. This simply refers to enabling a sender to send one message to a group of contacts simultaneously.

Indeed, it is readily apparent that Farwell fails to disclose or suggest at least controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient, essentially as claimed in claim 9.

Anderson fails to cure the deficiencies of Agrawal and Farwell. Anderson generally describes ‘folder rights’ in which documents in the shared folder carry their own set of rights, independent of the rights granted by the folder. In Anderson, users must be granted rights to

documents in a shared folder by the owner of the document. However, this is not to be confused with controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient, as presently claimed in claim 9. Instead, in Anderson, each document owner must separately grant the user the right to view the document. **There is no provision in Anderson enabling a user to control whether a recipient of an email message is be presented with a user-defined discussion topic heading or associated email messages to the email message being sent.**

Accordingly, it is respectfully asserted that independent Claims 1 and 15 are patentably distinct and non-obvious over Agrawal in view of Rosenschein for at least the reasons set forth above. Claims 4-6 and 8 depend from claim 1 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 1. Claims 16, 18 and 20 depend from claim 15 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 15. Claims 2, 3, 17 and 19 have been cancelled without prejudice.

Also, it is respectfully asserted that independent Claim 9 is patentably distinct and non-obvious over Agrawal in view of Anderson and/or Farwell for at least the reasons set forth above. Claims 10-14 depend from claim 9 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 9.

With respect to the §103 rejection of claim 7, the rejection of claim 7, is based, in part, on the contention that Agrawal discloses or suggests the features of claim 1, from which claim 7 respectively depends. However, in light of the above amendments and discussion, it is clear that the combination of Agrawal and/or Kekic is legally deficient, since, at the very

least, as explained above, Agrawal does not disclose or suggest the features of claim 1, from which claim 7 depends.

It is therefore respectfully submitted that the present invention is not disclosed or suggested by the cited references taken alone or in combination. Claims 1, 4-16 and 18 and 20 are believed to be in condition for allowance for at least the reasons stated above. Early and favorable reconsideration of the case is respectfully requested.


CONCLUSION

In view of the foregoing, Applicant respectfully requests that the rejections of the claims set forth in the Office Action of January 27, 2009 be withdrawn, that pending Claims 1, 4-16 and 18 and 20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No. 07-0832.

Respectfully submitted,

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